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PATENT & TRADEMARK OFFICE

GAU 1774

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PATENT
Docket No.: 54565USA4A.002

4/3/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

MARK F. SCHULZ and
OMAR FAROOQ

Serial No.: 09/314,034

Filed: May 18, 1999

Group Art Unit: 1774

Examiner: M. Grendzynski

For: MACROPOROUS INK RECEIVING MEDIA

RESPONSE TO RESTRICTION REQUIREMENT

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Commissioner for Patents
Washington, DC 20231

Dear Sir:

This response is to the Office Action mailed March 13, 2001.

Claims 1- 21 have been restricted under 35 U.S.C. § 121 as follows:

I. Claims 1-15 and 21 are said to be drawn to ink receiving media, classified in Class 428, subclass 195;

II. Claims 16-18 are said to be drawn to a method of making an ink receiving medium, classified in Class 427, subclass 372.2; and

III. Claims 19-20 are said to be drawn to a printed ink receiving medium, classified in Class 428, subclass 195.

Applicants hereby confirm election of Group I (i.e., claims 1-15 and 21), with traverse, and respectfully requests reconsideration and withdrawal or modification of the restriction.

In Group I, Applicants broadly claim an ink receiving media comprising a macroporous substrate having fluid and pigment management systems in contact with the macropores of the substrate.

The Restriction Requirement (Paper No. 5) in Paragraph 2 states in part:

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on:

MARCH 26 2001 — Kathleen M. Hoerr
Date — Signature

Inventions I and II are related as process of making and product made. In the instant case, the product claimed can be made by another, materially different process, for example, by applying the solution to a temporary carrier layer, drying it, then laminating the layer to the macroporous substrate. Paragraph 3 states in part: Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. In the instant case, the intermediate product is deemed to be useful as gift wrapping paper and the inventions are deemed patentably distinct since there is nothing on the record to show them obvious variants.

Notwithstanding that the Group III claims may not be obvious in view of the Group I claims, and that the Group I claims may be made by a process other than that claimed in the Group II claims, Applicants submit the inventions are so interrelated that a search of one group of claims will reveal art to the other. Further, the classification of Groups I, II, and III claims in different classes and subclasses is not sufficient grounds to require restriction. In fact, Group I and III claims are in the same class and subclass.

Were restriction to be effected between the claims in Groups I, II, and III, a separate examination of the claims in Groups I, II, and III would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I, II and III would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I, II, and III, it would place an undue burden on Applicants' assignee by requiring payment of a separate filing fee for examination of the non-elected claims, as well as the added costs associated with prosecuting three applications and maintaining three patents.

Paragraph 5 of the Restriction Requirement states in part:

In the event that the invention of Group I is chosen, this application contains claims directed to the following patentably distinct species of the claimed invention:

(a) an ink receiving medium of claims 1-11; (b) an ink receiving medium of claims 12-15; or (c) an ink receiving medium of claim 21.

Applicants elect claims 1-11 as the species to be searched under Group I. Applicants understand that upon allowance of a species claim that the Patent Office will search the genus.

Respectfully submitted,

By _____
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